



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,125	01/19/2001	Jonathan E. Lowthert	42390P10483	9472
21906	7590	06/15/2006	EXAMINER	
TROP PRUNER & HU, PC 1616 S. VOSS ROAD, SUITE 750 HOUSTON, TX 77057-2631			RAMAN, USHA	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,125

Applicant(s)

LOWTHERT ET AL.

Examiner

Usha Raman

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 62-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 62-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed March 22nd, 2006 have been fully considered but they are not persuasive.

Applicant argues that Knepper merely discloses a sequence of play of advertisement and therefore does not teach the limitations of claims 62 and 71. The examiner respectfully disagrees. Knepper also teaches the step of determining the location of ad based on various criteria during the playback of the entertainment clip. As a result, Knepper discloses that conditions may occur that determine the placement of the ads, wherein the timing of the condition itself is unknown. See [0084]. The rejection is thus maintained.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 62-78 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 62 and 71 disclose the limitation of including a "unique content identifier" in the info segment. While applicant's disclosure shows that an info segment contains one content identifier, it does not disclose that the content

identifier is unique. See figure 3 in applicant's disclosure. The claims have been examined in the interpretation of the info segment having one content identifier, as the purpose of a requiring unique content identifier is not understood.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 62, 63, 66, 69-74, 77, and 79-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Knepper et al. (US Pre Grant Pub. 2001/0042249)

In regards to claim 62, Knepper discloses a system comprising:

A transmitter to transmit an info segment (instruction set) including a content identifier to specify one particular content item (entertainment file such as movie or a show), the info segment also including an interruption point specifier (tags including the ADOverlay tag) to identify a condition that ("various criteria" for determining location of ad within a show), if detected will cause the display of an advertisement to replace the display of the one particular content item (see Knepper: [0060] and [0065]), wherein the place in the content where the occurrence of the condition might happen during use of the one particular content item is not known (See [0084], "ad

location within a show maybe determined by various criteria at the time of playback"; therefore the place in content); and

A storage (105) to store the info segment (instruction set) until the info segment is transmitted to a receiver. See Knepper: [0026]

In regards to claim 63, Knepper discloses that the storage stores an info segment including a plurality of fields, one field comprising said interruption point specifier (tags), another field selected from the group consisting of a permitted ad type specifier (ratings), and a prohibited ad type specifier (due to association, see [0061] and [0072]); and

The transmitter transmits info segment separately from the content item (content maybe pre-cached, while info segment is delivered upon request for playback; see [0009] and [0011]

In regards to claims 66, and 82, the transmitter (server) transmits the info segment ("instruction set" for correlating advertisements with media programs) to the receiver upon request. See Knepper: [0011], [0014], [0026].

In regards to claim 68, the system of Knepper further includes an info segment generator (i.e. to create the instruction set prior to transmitting to client) to insert a content identifier and an interruption point specifier in said info segment (the instruction set further contains content identifier to identify primary content being played and interruption point specifier to indicate where ads should be placed). See Knepper: [0009], [0034].

In regards to claims 69, 73 and 81, the system includes ad entry generator (since ad entries are created by the server in the instruction set, the system inherently comprises an ad entry generator) to insert said interruption point specifier in said info segment as an ad entry parameter (see Knepper: [0034], [0053], [0054]), and to insert another ad entry parameter (association 609) consisting of a permitted ad type specifier (i.e. type of advertisement that may be appropriate for a given entertainment file). See Knepper: [0061].

In regards to claim 70, the system receives at the receiver (i.e. the client 203) the info segment from an external source (i.e. server 207). See Knepper: [0034]

In regards to claim 71, Knepper discloses a method comprising:

Associating one info segment (instruction set) with one particular content item (entertainment file such as movie or a show);

Associating the interruption point indicator (ADOverlay tag) with the one info segment, the interruption point indicator to indicate a condition that if satisfied (i.e. when one of the various criteria is determined) will cause an advertisement to be displayed in place of the one particular program content item (see [0060], [0065]), the timing of the satisfaction of the condition during play of the particular content item unknown when the interruption point indicator is associated with the info segment (since ad location within a show is determined at the time of playback based on various criteria, the timing of the condition itself unknown; see [0084]); and

Delivering the info segment together with the interruption point indicator to a receiver (see [0009]).

In regards to claim 72, Knepper includes the step of inserting a content identifier (entertainment clip name) in said info segment (instruction set), the content identifier to indicate the one particular content item (i.e. the entertainment file such as movie, or a show) with which said info segment is associated. See Knepper: [0009], [0034].

In regards to claim 74, see claims 66. In further regards to claim 74, the transmitter transmits info segment separately from the content item (content maybe pre-cached, while info segment is delivered upon request for playback; see [0009] and [0011])

In regards to claim 77, Knepper discloses delivering the instruction set over computer network, particularly the Internet, which is a packet switched network. See abstract, [0002].

In regards to claim 79, Knepper discloses a medium storing instructions that (instruction set), if executed enable a system to:

Associate an info segment (instruction set) with a content item (entertainment object); see Knepper: [0014]

Associate an interruption point indicator with said info segment (placement of ADInsert tags associates interruption point with the info segment), the interruption point indicator to indicate a point in the content item to insert an advertisement (location of the ADInsert tag within the instruction set, indicates the point in the content item to insert the advertisement); see Knepper: [0053], [0054] and

Deliver said info segment including said interruption point indicator to a receiver.

See [0009].

In regards to claim 80, Knepper discloses the method of enabling the system to insert a content identifier in the info segment, the content identifier indicating the content item with which to associate the info segment (server creates a instruction for an entertainment file)

6. Claims 79, 83-86 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al. (US Pat. 6,698,020).

In regards to claim 79, Zigmond discloses a method comprising:

Associating an info segment (ad selection criteria; see Zigmond: column 11, lines 43-47) with a content item (identified by program identifier, see Zigmond: column 10, lines 64-67, column 11 lines 1-2);

Associating an interruption point indicator with said info segment (see Zigmond: column 17, lines 24-31), the interruption point indicator to indicate a point in the content item to insert an advertisement; and

Delivering said info segment including said interruption point indicator to a receiver (see Zigmond: column 12, lines 1-14).

In regards to claim 83, the transmitter transmits info to the receiver without request. See Zigmond: column 12, lines 1-14.

In regards to claim 84, Zigmond discloses delivering the info segment (ad selection criteria) advertisement delivery channels, including broadcast signals (i.e. airwave). See Zigmond: column 12, lines 1-9.

In regards to claim 85, Zigmond discloses the step of delivering info segment over a packet-switched network (information maybe delivered over the WWW, which uses the TCP/IP and is thus utilizes the packet switched network). See Zigmond: column 12, lines 1-9.

In regards to claim 86, Zigmond discloses delivering pre-installed ad selection criteria in ad insertion devices (and therefore are recorded onto the devices on a recordable medium). See Zigmond: column 12, lines 6-12.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 65 rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper et al. (US Pre Grant Pub. 2001/0042249).

In regards to claim 65, while Knepper discloses that media files maybe delivered to the user over a variety of communications networks (see [0091], Knepper is silent that the system can be a television broadcaster.

Examiner takes official notice that is well known to delivery media files over a television network by television broadcaster.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper to include a television broadcaster, thereby providing media and targeted advertisements to television viewers.

9. Claims 64, 67, 75-76 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knepper et al. (US Pat. 2001/0042249) in view of Zigmond et al. (US Pat. 6,698,020).

In regards to claim 64, Knepper is silent about storing an electronic program guide in the storage, having a program identifier and an associated info segment.

Zigmond discloses storing an EPG at the subscriber premises having a program identifier (see Zigmond: column 10, lines 64-67, column 11 lines 1-2) and an associated "info segment" (see Zigmond: column 11, lines 43-47) that determines what advertisements should be placed in the program identified by the program identifier.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper by storing an EPG at the user premises, thereby providing a cataloged listing of programs available to the user.

In regards to claims 67, and 75, Knepper does not disclose that the transmitter transmits info to the receiver without request.

Zigmond discloses the step of transmitting info segment (containing ad rules for targeting) that are transmitted to the receiver without request. See Zigmond: column 12, lines 1-14.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Knepper to include the mechanism of "pushing" the info segment to the receiver, thereby enabling the targeting of advertisements to television audiences.

In regards to claims 76, Knepper discloses the step of delivering the instruction set over communications network (see [0092]), however is silent on delivering the info segment over airwaves.

Zigmond discloses delivering the info segment (ad selection criteria) advertisement delivery channels, including broadcast signals (i.e. airwave). See Zigmond: column 12, lines 1-9.

It would have been obvious to one of ordinary skill at the time of the invention to modify the system in view of Zigmond by delivering the info segment over the airwaves thereby delivering it to broadcast television viewers.

In regards to claims 78, Knepper is silent on delivering the info segment on a recordable medium.

Zigmond discloses delivering pre-installed ad selection criteria in ad insertion devices (and therefore are recorded onto the devices on a recordable medium). See Zigmond: column 12, lines 6-12.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system by delivering the info segment on a recordable medium as taught by Zigmond, thereby enabling targeted advertisements for programs in a recordable medium.

Conclusion


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

Art Unit: 2623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UR


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600